

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETER BUSE and WILLI GRANDMANN

Appeal No. 2000-0875
Application No. 08/945,138

ON BRIEF

Before COHEN, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 10 and 14 to 18, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a method for ironing a cup and an ironing tool for ironing a cup. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Phalin et al. (Phalin)	4,502,313	March 5, 1985
Okakda et al. (Okakda)	JP 4-100639 ¹	April 2, 1992

Claims 10 and 14 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Okakda in view of Phalin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No.

¹ In determining the teachings of Okakda, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

12, mailed January 25, 1999) and the answer (Paper No. 19, mailed November 9, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 18, filed September 30, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 10 and 14 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue (brief, pp. 5-14) that the applied prior art (i.e., Okakda and Phalin) does not suggest the claimed subject matter. We agree. All the claims under appeal recite a plurality/several ironing rings through which a cup is pushed by a mandrel. We have reviewed the teachings of the applied prior art and find no teaching or suggestion therein of a plurality/several ironing rings through which a cup is pushed by a mandrel.² Since the applied prior art

² The appellants admit that a plurality/several ironing rings through which a cup is pushed by a mandrel as shown in Figure 2 is prior art (specification, p. 3), however, the examiner has not utilized this admission in the rejection before us in this appeal.

would not have been suggestive of the claimed invention, we cannot sustain the examiner's rejections of claims 10 and 14 to 18.

REMAND

We remand the application to the examiner to consider on the record whether or not claims 10 and 14 to 18 are patentable under 35 U.S.C. § 103 over the combined teachings of the admitted prior art shown in Figure 2 (note footnote 2), Okakda and Phalin.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10 and 14 to 18 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further action.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, Rev. 1, Feb. 2000).

REVERSED and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

Appeal No. 2000-0875
Application No. 08/945,138

Page 7

DUANE, MORRIS, & HECKSCHER LLP
ONE LIBERTY PLACE
PHILADELPHIA, PA 19103-7396

Appeal No. 2000-0875
Application No. 08/945,138

Page 8

JVN/dl